Remarks

Claims 1 to 19 are pending. No claims have been canceled. Claims 20 to 29 have been withdrawn from consideration. Claims 1- 22, 25 and 29 are amended. Claims 20-29 have been withdrawn from consideration. No claims have been added. The amendments presented herewith are merely to correct minor errors noted when preparing Applicant's Appeal Brief of December 18, 2003. No new matter has been introduced.

In the telephone interview of May 18, 2004, S.P.E. McKane expressed some confusion over which set of claims were pending. Applicant's Agent believes that claims 1-19, as amended herein, are pending. A new claim set 30-47 was submitted by amendment on July 29, 2003. This amendment was rejected in an Office Action dated 8/25/2003 due to an alleged New Matter. The New Matter rejection was vacated in an Advisory Action dated 10/22/2003, but the amendment was still not entered for reasons stated in that Advisory Action. Thus, claims 1 to 19 are pending. This is confirmed by the Office Action dated 5/5/2004, which refers to claims 1-19.

Rejoinder

Applicants respectfully request Rejoinder, under M..P.E.P. 821.04, of the withdrawn claims 20-29, should claims 1-19 be found allowable. Each of the sets of withdrawn claims are dependent on the composition of claim 1, which is believed to be allowable. The withdrawn claims have been amended herein to correct minor informalities.

§ 112 Rejections: First Paragraph

The present Office Action is silent on the status of the outstanding rejection of claims 1, 2, 4, 6, 9, 10, 14 and 16 to 18 under 35 USC § 112, first paragraph, and the subject of Applicant's Appeal Brief filed December 18, 2003. In a telephone interview on May 18, 2004 with Examiner Oh and S.P.E. McKane, withdrawal of the rejections was confirmed.

§ 112 Rejections: Second Paragraph

Claims 1, 2, 4, 8-10 and 16 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejections are traversed.

The Office Action asserts that the phrases "one or more fluorinated polyols" and "one or more polyisocyanates" are vague and indefinite because "there are so may kinds of polyols and polyisocyanates in the art...".

The test for definiteness under 35 U.S.C. § 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertain in the example above, the meaning of the terms "one or more fluorinated polyols" and "one or more polyisocyanates" in light of the specification, 35 U.S.C. § 112, second paragraph is satisfied.

The term "fluorinated polyol" is found in claims 1, 9, 10 (as amended), 11 (as amended), and 12 (as amended). Applicants have provided an abundant description of the term on page 13, line 7 to page 15, line 32, and have included numerous specific examples of useful fluorinated polyols, and the preparation thereof at page 38, line 24 through page 39, line 28. The term "polyol" *per se* is defined at page 8, lines 5-7. Clearly, one skilled in the art would understand Applicant's use of the term.

The term "one or more polyisocyanates" is found in claims 1 and 9. The word "polyisocyanate" is found in claim 14. The term is specifically defined on page 8, lines 1 to 4, and on page 11, line 8 to page 13, line 6 and include many illustrative examples of useful polyisocyanates, including those described on page 40, line 19 through page 41, line 8. One skilled in the art would understand Applicant's use of the term.

The Office Action further rejects instant claims 1, 2, 4, 8-10 and 16 for the term "comprising". The rejections are traversed.

In support of each of the rejections, the Office Action states "[t]he expression of the word 'comprising' would mean that there are additional components besides compounds or oligomers". Just so.

As noted in M.P.E.P. 2111.03, the transitional phrase "comprising" is open-ended and does not exclude additional unrecited elements. The use of the term is a well-established practice and has a clear meaning.

With respect to the instant claim 1, the first instance of the word "comprising" modifies the composition *per se*, to allow the composition to have additional elements. As an example, one may refer to claim 17, where the composition contains a solvent. This is further described on page 29, lines 13 to 28.

In the second instance, the term appears in the context of "said oligomers comprise the condensation reaction products of...". Thus the second instance modifies the term oligomers, rather than the composition. A cursory review of Applicant's claims would indicate that the instant fluorochemical oligomers of claim 1, and defined as the reaction product of reactants (a), (b) and (c), may further be the reaction product of additional reactants, such as those defined in claim 2; the water-solubilizing compounds. Thus claim 1 was deliberately open-ended, using the appropriate transitional claim language, to allow for such further reactants.

Although not noted by the Examiner, in the third instance, the word "comprising" appears in the context of "monofunctional fluorine-containing compounds comprising one functional group...". As these reactants are described on page 18, line 12 to page 22, line 28, it is not believed that the word "comprising" introduces any uncertainty into the claim.

In the telephone interview of May 18th, S.P.E. McKane suggested the term "comprising" may not be appropriate in claim 8. However, as amended herein, claim 8 recites "the fluorochemical urethane composition of claim 1 comprising..., and in this context (composition...comprising), it is believed that the term is proper, as the composition allows for other components, e.g. solvents, water, as previously argued.

As the term has a well recognized meaning, is used in an appropriate context, and there is no art rejection that would preclude such open-ended language, Applicants assert the rejections of claims 1, 2, 4, 8-10 and 16 are improper and should be withdrawn.

In summary, Applicants submit that the rejection of claims 1, 2, 4, 8-10 and 16 under 35 USC § 112, second paragraph, has been overcome, and that the rejections should be withdrawn.

§ 102 Rejections

Claims 1-4 and 10 stand rejected under 35 USC § 102(b) as being anticipated by WO 93/01349 (Smith et al.). The rejection is traversed.

Applicant's Agent notes that the same rejection was asserted in the Office Action dated 12/27/2002 and overcome by the response filed 2/26/2003. The rejection was withdrawn in the subsequent Office Action dated 5/21/2003. In a telephone call to the Examiner on 5/14/2004, the Examiner admitted the rejection was a "mistake".

The rejection of claims 1-4 and 10 under 35 USC § 102(b) as being anticipated by WO 93/01349 (Smith et al.). has been previously overcome and should be withdrawn.

Reconsideration of the application is requested. In view of the above, it is submitted that the application is in condition for allowance. Allowance of claims 1 to 19, as amended, at an early date is solicited. Rejoinder of withdrawn claims 20-29 is additionally solicited.

Respectfully submitted,

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